



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,446	12/09/2004	Yoshihide Ueno	0020-5328PUS1	8646
2292	7590	07/20/2006		EXAMINER
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				FREISTEIN, ANDREW B
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/517,446	UENO ET AL.
	Examiner Andrew B. Freistein	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) 1-13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/04; 2/18/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 1-16 are currently pending.

Priority

This application is a 371 of PCT/JP03/07382, filed 06/10/2003.

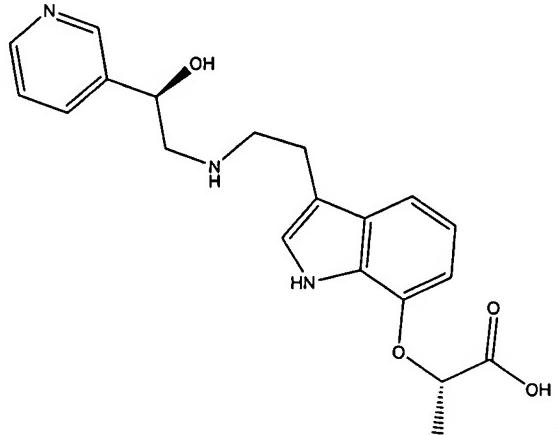
Acknowledgement is made of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d), by Japan patent application 2002-171400 filed on 06/12/2002 and Japan patent application 2003-027529, filed 02/04/2003.

Information Disclosure Statement

Applicant's information disclosure statements (IDS), filed on 12/09/2004 and 02/18/2005, have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Restriction Requirement

In a response filed 06/19/2006, Applicant elected Claims 1-13 (in part) (without

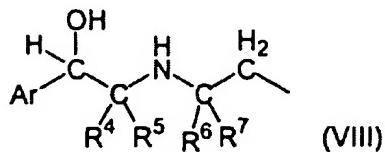


traverse) the species of Example 146, , and a modified Group V, labeled "Group Va", which is drawn to products of the formula (I), in which:

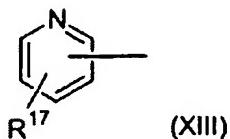
Art Unit: 1626

 R^1 is X-

R^{1c} -C(=O)NR^{1a}R^{1b}, X-R^{1c}-C(=O)OR^{1a} or X-R^{1d}, X is O, S or SO₂N(R^{1c}), R² is H or lower alkyl;
 Q is C(W) = C(R^{3A})-N(R³) or C(R^{3A})=C(W)-N(R³); R³ is H or lower alkyl; W is formula (VIII)



R^4 , R^5 , R^6 and R^7 are H or lower alkyl; Ar is a group of the formula (XIII)



And R^{17} is H, halogen or a cyano group.

Furthermore, Applicant chose to refrain from electing a method of use in the response to the restriction requirement.

Examiner may reconsider to rejoin the method of use claims commensurate in scope with the product claims when and if the case is found to be in condition for allowance provided those method of use claims are free of 35 U.S.C. § 112 first and second paragraph issues (including written description, reach-through claim language and/or scope of enablement issues).

Applicants reserve their right to file a divisional application on the non-elected subject matter.

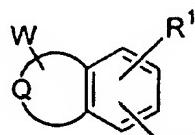
Status of the Claims

Claims 1-13 (in part) are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR § 1.142(b). The withdrawn

subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

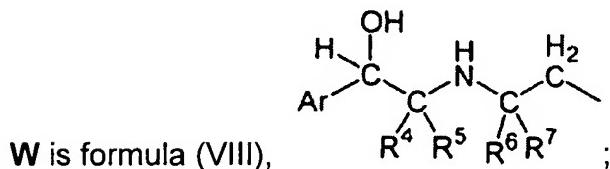
Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



Compounds of the Formula (I),

Q is $C(W)=C(R^{3A})-N(R^3)$ or $C(R^{3A})=C(W)-N(R^3)$;



W is formula (VIII),

R^{3A}, **R**⁴, **R**⁵, **R**⁶, and **R**⁷ are each independently as defined in claim 1;

R¹ is $X-R^{1e}-C(=O)NR^{1a}R^{1b}$, $X-R^{1e}-C(=O)OR^{1a}$ or $X-R^{1d}$;

X is O, S or $SO_2N(R^{1c})$;

R^{1e} is as defined in claim 1;

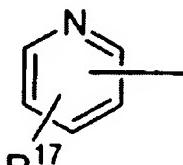
R^{1a}, **R**^{1b} and **R**^{1c} are each independently H, lower alkyl, aralkyl, aryl or cycloalkyl, each of which is optionally substituted as defined in claim 1;

R^{1d} is H, alkyl, phenyl or a cycloalkyl group in which a CH_2 moiety is *not* replaced by O or $N(R^{1a})$, each of which is optionally substituted;

R² is H, halogen, alkyl, lower alkenyl, amino, hydroxyl, or alkoxy, each of which is optionally substituted as defined in claim 1;

Art Unit: 1626

R^3 is as defined in claim 1;

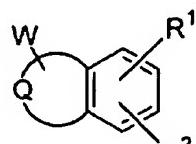


Ar is formula (XIII), R^{17} ; and

R^{17} is as defined in claim 1.

Non-elected and Non-examined Subject Matter

The scope of the invention of the non-elected and non-examined subject matter is as follows:



Compounds of the Formula (I),

$-C(W)=N-N(R^3)-$, $-C(R^{3A})=N-N(W)-$,

Q is $-N=C(W)-N(R^3)-$, $-N=C(R^{3A})-N(W)-$, $-C(W)=N-O-$, or $-C(W)=N-S-$;

R^1 combines with R^2 to form a methylenedioxy group;

X is $-N(R^{1c})-$, $-N(R^{1c})C(=O)-$, $-C(=O)N(R^{1c})-$, $-N(R^{1c})SO_2-$, or $-C(=O)NHSO_2-$;

R^{1a} , R^{1b} and R^{1c} are each independently a heterocyclic group, or R^{1a} and R^{1b} combine with the adjacent N atom to form a 3- to 8- membered cyclic amino group;

R^{1d} is a cycloalkyl group in which one or more CH_2 moiety is replaced by O or $N(R^{1a})$;

R^2 is combines with R^1 to form a methylenedioxy group; and

Ar is formula (IX) or (X).

As a result of the election and the corresponding scope of the invention, identified supra, the remaining subject matter of Claims 1-13 is withdrawn from further

Art Unit: 1626

consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions.

The withdrawn compounds contain varying functional groups such as benzodioxolane, benzothiazole, benzoxazole, morpholine, etc. which are chemically recognized to differ in structure, function, and reactivity.

Therefore, the subject matter which was withdrawn from consideration as being non-elected subject matter materially differs in structure and composition from the elected/examined subject matter so that a reference which anticipates the elected/examined subject matter would not render obvious the non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the definition of R¹ is:

optionally substituted lower alkyl group, or a group of the formula: -X-R^{1c}-C(=O)NR^{1a}R^{1b}, -X-R^{1c}-C(=O)OR^{1a} or -X-R^{1d} (where X is a direct bond or a group of the formula: -O-, -S-, -N(R^{1c})-, -N(R^{1c})C(=O)-, -C(=O)N(R^{1c})-, -N(R^{1c})SO₂-, -SO₂N(R^{1c})-, or -C(=O)NHSO₂-,

It is difficult to interpret where the definition of R¹ starts and ends and where the definition of X ends. The open parenthesis "(" after the variable -X-R^{1d} and before the

Art Unit: 1626

word "where" is confusing. There is no closing parenthesis ")", which makes the definition of X or R¹ to each include

-C(=O)N(R^{1c})-, -N(R^{1c})SO₂-, -SO₂N(R^{1c})-, or -C(=O)NHSO₂-.

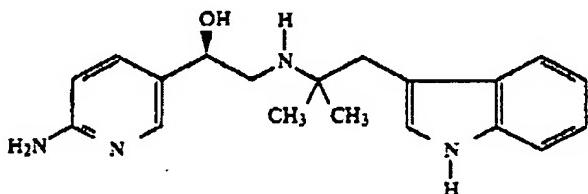
In order to obviate the objection, the closed parenthesis must be inserted to identify what the definition of X is.

Claim Objections

Claims 1-13 are objected to as being drawn to non-elected subject matter.

Closest Relevant Art

The closest relevant art is Fisher et al., US 5030640, which discloses the



compound: (see col. 9, Ex. 3). The prior art compound has a pyridinyl group substituted with an NH₂ group. However, the instant application has a pyridyl group substituted with H, halogen, or cyano and not NH₂.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1626

Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein
Patent Examiner, AU 1626

for 

Joseph K. McKane
Supervisory Patent Examiner, AU 1626
Date: July 11, 2006